

PATENT COOPERATION TREATY

BEST AVAILABLE COPY

PCT

NOTIFICATION OF ELECTION

(PCT Rule 61.2)

From the INTERNATIONAL BUREAU

To:

United States Patent and Trademark
Office
(Box PCT)
Crystal Plaza 2
Washington, DC 20231
ETATS-UNIS D'AMERIQUE

in its capacity as elected Office

Date of mailing (day/month/year) 02 September 1998 (02.09.98)	
International application No. PCT/EP98/00794	Applicant's or agent's file reference 4 -21233/A
International filing date (day/month/year) 12 February 1998 (12.02.98)	Priority date (day/month/year) 14 February 1997 (14.02.97)
Applicant SCHLÜTERMANN, Burkhard	

1. The designated Office is hereby notified of its election made:

☒ in the demand filed with the International Preliminary Examining Authority on:

18 August 1998 (18.08.98)

☐ in a notice effecting later election filed with the International Bureau on:

2. The election ☒ was
☐ was not

made before the expiration of 19 months from the priority date or, where Rule 32 applies, within the time limit under Rule 32.2(b).

<p>The International Bureau of WIPO 34, chemin des Colombettes 1211 Geneva 20, Switzerland</p> <p>Facsimile No.: (41-22) 740.14.35</p>	<p>Authorized officer Yolaine CUSSAC</p> <p>Telephone No.: (41-22) 338.83.38</p>
--	--

PATENT COOPERATION TREATY

PCT


REC'D 20 APR 1999

WIPO

PCT

INTERNATIONAL PRELIMINARY EXAMINATION REPORT

(PCT Article 36 and Rule 70)

Applicant's or agent's file reference 4 -21233/A		FOR FURTHER ACTION See Notification of Transmittal of International Preliminary Examination Report (Form PCT/IPEA/416)	
International application No. PCT/EP98/00794	International filing date (day/month/year) 12/02/1998	Priority date (day/month/year) 14/02/1997	
International Patent Classification (IPC) or national classification and IPC A61K31/55			
Applicant NOVARTIS AG et al.			
<p>1. This international preliminary examination report has been prepared by this International Preliminary Examining Authority and is transmitted to the applicant according to Article 36.</p> <p>2. This REPORT consists of a total of 4 sheets, including this cover sheet.</p> <p><input type="checkbox"/> This report is also accompanied by ANNEXES, i.e. sheets of the description, claims and/or drawings which have been amended and are the basis for this report and/or sheets containing rectifications made before this Authority (see Rule 70.16 and Section 607 of the Administrative Instructions under the PCT).</p> <p>These annexes consist of a total of sheets.</p>			
<p>3. This report contains indications relating to the following items:</p> <ul style="list-style-type: none">I <input checked="" type="checkbox"/> Basis of the reportII <input type="checkbox"/> PriorityIII <input type="checkbox"/> Non-establishment of opinion with regard to novelty, inventive step and industrial applicabilityIV <input type="checkbox"/> Lack of unity of inventionV <input checked="" type="checkbox"/> Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statementVI <input type="checkbox"/> Certain documents citedVII <input type="checkbox"/> Certain defects in the international applicationVIII <input checked="" type="checkbox"/> Certain observations on the international application			
Date of submission of the demand 18/08/1998		Date of completion of this report 19.04.99	
Name and mailing address of the international preliminary examining authority:  European Patent Office D-80298 Munich Tel. (+49-89) 2399-0 Tx: 523656 epmu d Fax: (+49-89) 2399-4465		Authorized officer Beeck, M Telephone No. (+49-89) 2399 8473	



INTERNATIONAL PRELIMINARY EXAMINATION REPORT

International application No. PCT/EP98/00794

I. Basis of the report

1. This report has been drawn on the basis of (*substitute sheets which have been furnished to the receiving Office in response to an invitation under Article 14 are referred to in this report as "originally filed" and are not annexed to the report since they do not contain amendments.*):

Description, pages:

1-13 as originally filed

Claims, No.:

1-10 as originally filed

2. The amendments have resulted in the cancellation of:

- ☐ the description, pages:
☐ the claims, Nos.:
☐ the drawings, sheets:

3. ☐ This report has been established as if (some of) the amendments had not been made, since they have been considered to go beyond the disclosure as filed (Rule 70.2(c)):

4. Additional observations, if necessary:

V. Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement

1. Statement

Novelty (N)	Yes:	Claims	1-10
	No:	Claims	
Inventive step (IS)	Yes:	Claims	
	No:	Claims	1-10
Industrial applicability (IA)	Yes:	Claims	1-10
	No:	Claims	

**INTERNATIONAL PRELIMINARY
EXAMINATION REPORT**

International application No. PCT/EP98/00794

2. Citations and explanations

see separate sheet

SECTION V:

- 1) The subject-matter of the claims is novel.
- 2) However, it does not involve an inventive step for the following reasons:

Document EP-A-0646374 is considered as the closest prior art document. It describes formulations comprising oxcarbazepine (see the whole document).

The subject-matter of the claims differs therefrom in that the median particle size is 2 to 12 μm .

However, it is prima facie obvious for the person skilled in the art that particles with a median particle size of 2 to 12 μm would have the same properties as particles as described in EP-A-0646374.

Therefore the subject-matter of claims 1 to 10 does not involve an inventive step.

- 3) The Applicant should show, for example by comparative tests, that the compounds with a median particle size of 2 to 12 μm present unexpected effects or properties in relation to those described in the above mentioned prior art.

SECTION VIII:

The expression "approximately" should be deleted from claims 1 to 4, 6, 7, 9 and 10 since it renders the scope for which protection is sought obscure (see the Guidelines, C III, 4.5a).

INTERNATIONAL SEARCH REPORT

International Application No

PCT/EP 98/00794

A. CLASSIFICATION OF SUBJECT MATTER
IPC 6 A61K31/55 A61K9/28

According to International Patent Classification (IPC) or to both national classification and IPC

B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

IPC 6 A61K

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practical, search terms used)

C. DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
X	EP 0 646 374 A (CIBA-GEIGY) 5 April 1995 cited in the application see the whole document ---	1-10
A	WO 94 13298 A (RHONE-POULENC RORER) 23 June 1994 see claims see example A ---	1-10
A	WO 95 29665 A (ALZA) 9 November 1995 see claims see examples ---	1-10
A	WO 94 20110 A (RHONE-POULENC RORER) 15 September 1994 see claims see example A ---	1-10
	-/--	

☒ Further documents are listed in the continuation of box C.

☒ Patent family members are listed in annex.

*** Special categories of cited documents :**

- "A" document defining the general state of the art which is not considered to be of particular relevance
- "E" earlier document but published on or after the international filing date
- "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another citation or other special reason (as specified)
- "O" document referring to an oral disclosure, use, exhibition or other means
- "P" document published prior to the international filing date but later than the priority date claimed

- "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention
- "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone
- "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art.
- "&" document member of the same patent family

Date of the actual completion of the international search

8 July 1998

Date of mailing of the international search report

16/07/1998

Name and mailing address of the ISA

European Patent Office, P.B. 5818 Patentlaan 2.
NL - 2280 HV Rijswijk
Tel. (+31-70) 340-2040, Tx. 31 651 epo nl,
Fax: (+31-70) 340-3016

Authorized officer

Scarponi, U

INTERNATIONAL SEARCH REPORT

International Application No

PCT/EP 98/00794

C.(Continuation) DOCUMENTS CONSIDERED TO BE RELEVANT

Category	Citation of document, with indication, where appropriate, of the relevant passages	Relevant to claim No.
A	<p>US 4 409 212 A (CESARE MONDADORI) 11 October 1983 see claims see examples</p> <p>-----</p>	1-10

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/EP 98/00794

Patent document cited in search report		Publication date	Patent family member(s)	Publication date
EP 646374	A	05-04-1995	AT 164762 T	15-04-1998
			AU 678492 B	29-05-1997
			AU 7157194 A	23-03-1995
			CA 2131495 A	09-03-1995
			DE 59405627 D	14-05-1998
			ES 2115188 T	16-06-1998
			JP 7165584 A	27-06-1995
			NZ 264407 A	21-12-1995
			SG 44498 A	19-12-1997
			US 5472714 A	05-12-1995
			US 5695782 A	09-12-1997
			ZA 9406874 A	24-04-1995
<hr/>				
WO 9413298	A	23-06-1994	FR 2699077 A	17-06-1994
			AT 164067 T	15-04-1998
			AU 5653994 A	04-07-1994
			AU 678795 B	12-06-1997
			AU 5654094 A	04-07-1994
			AU 5702094 A	04-07-1994
			CA 2151601 A	23-06-1994
			CA 2151603 A	23-06-1994
			CA 2151604 A	23-06-1994
			CZ 9501545 A	15-11-1995
			CZ 9501546 A	15-11-1995
			CZ 9501547 A	15-11-1995
			DE 69317578 D	23-04-1998
			DK 674512 T	25-05-1998
			EP 0674520 A	04-10-1995
			EP 0674512 A	04-10-1995
			EP 0674518 A	04-10-1995
			ES 2113635 T	01-05-1998
			WO 9413296 A	23-06-1994
			WO 9413288 A	23-06-1994
			FR 2699079 A	17-06-1994
			FR 2699078 A	17-06-1994
			HU 71814 A	28-02-1996
			HU 71839 A	28-02-1996
			HU 71812 A	28-02-1996
			JP 8504428 T	14-05-1996
			JP 8504429 T	14-05-1996

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/EP 98/00794

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
WO 9413298 A		JP 8504430 T	14-05-1996
		MX 9307882 A	30-06-1994
		MX 9307883 A	30-06-1994
		MX 9307884 A	30-06-1994
		NO 952228 A	06-06-1995
		NO 952229 A	06-06-1995
		NO 952230 A	06-06-1995
		PL 309346 A	02-10-1995
		PL 309347 A	02-10-1995
		PL 309348 A	02-10-1995
		SK 78595 A	08-05-1996
		SK 78695 A	08-05-1996
		SK 78795 A	08-05-1996
		ZA 9309399 A	22-08-1994
		ZA 9309400 A	19-08-1994
		ZA 9309401 A	19-08-1994
WO 9529665 A	09-11-1995	AU 2291295 A	29-11-1995
		CA 2184395 A	09-11-1995
		EP 0758228 A	19-02-1997
		JP 9512550 T	16-12-1997
		NZ 284326 A	24-04-1997
		US 5660861 A	26-08-1997
		ZA 9503078 A	05-01-1996
WO 9420110 A	15-09-1994	FR 2702148 A	09-09-1994
		AT 147981 T	15-02-1997
		AU 675118 B	23-01-1997
		AU 6143794 A	26-09-1994
		AU 6143894 A	26-09-1994
		AU 675119 B	23-01-1997
		AU 6143994 A	26-09-1994
		CA 2154571 A	15-09-1994
		CA 2154572 A	15-09-1994
		CA 2154573 A	15-09-1994
		CZ 9502259 A	13-12-1995
		CZ 9502260 A	13-12-1995
		CZ 9502261 A	13-12-1995
		DE 69401577 D	06-03-1997
		DE 69401577 T	15-05-1997

INTERNATIONAL SEARCH REPORT

Information on patent family members

International Application No

PCT/EP 98/00794

Patent document cited in search report	Publication date	Patent family member(s)	Publication date
WO 9420110 A		DK 687177 T	10-02-1997
		EP 0687176 A	20-12-1995
		EP 0687179 A	20-12-1995
		EP 0687177 A	20-12-1995
		ES 2096455 T	01-03-1997
		WO 9420103 A	15-09-1994
		WO 9420108 A	15-09-1994
		HU 73434 A	29-07-1996
		HU 73433 A	29-07-1996
		IL 108844 A	04-01-1998
		JP 8507507 T	13-08-1996
		JP 8507508 T	13-08-1996
		JP 8507509 T	13-08-1996
		NO 953370 A	28-08-1995
		NO 953371 A	28-08-1995
		NO 953372 A	28-08-1995
		PL 310474 A	11-12-1995
		PL 310475 A	11-12-1995
		PL 310476 A	11-12-1995
		SK 107495 A	05-06-1996
		SK 107595 A	05-06-1996
		SK 107695 A	05-06-1996
		US 5624945 A	29-04-1997
		US 5629312 A	13-05-1997
		ZA 9401525 A	09-11-1994
		ZA 9401530 A	06-10-1994
US 4409212 A	11-10-1983	CH 649080 A	30-04-1985
		AU 8263382 A	21-10-1982
		BE 892882 A	18-10-1982
		JP 57181013 A	08-11-1982
		ZA 8202568 A	29-12-1982